REMARKS

STATUS OF CLAIMS

In response to the Office Action dated October 8, 2008, claims 1, 2, 7, 12-15, 20, 25 and 26 have been amended. Claims 1-26 are now pending in this application.

CLAIM OBJECTIONS

Claims 7, 13-19, 25 and 26 have been objected to under 35 CFR 1.75 as being substantially duplicate of claims.

The objections are respectfully traversed.

I. The Examiner contends that claim 7 is a substantial duplicate of claims 12 and 13, and claim 13 is a substantial duplicate of claim 12. Independent claim 7 is directed to "An ***information transmitter*** that transmits information to outside". Independent claim 12 is directed to "A ***data storage system***" that comprises an information transmitter (e.g., as recited in claim 7) as an element, but further includes "a ***data storage device***", "a ***reception means***" and "a ***name generation means***", which are not recited in independent claim 7. Independent claim 13 is directed to "An ***information processing system***" that comprises an information transmitter (e.g., as recited in claim 7) as an element, but further includes "an ***information processor*** for performing a predetermined processing based on the piece of code information transmitted from the information transmitter", which is not recited in independent claims 7 and 12.

Since each of independent claims 7, 12 and 13 is directed to a different apparatus, claim 12 recites elements that are not recited in claims 7 and 13, and claim 13 recites elements that are not recited in claims 7 and 12, the claims all have a different scope. Therefore, no reasonable

basis exists for the Examiner to contend that claim 7 is a substantial duplicate of claims 12 and 13, and that claim 13 is a substantial duplicate of claim 12.

II. The Examiner contends that independent claim 14 is a substantial duplicate of independent claim 1. However, independent claim 1 comprises:

> an ***extraction means*** for extracting a piece of code information which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit; and
> a ***name generation means*** for generating a folder name or a file name relating to the data based on the piece of code information extracted by the extraction means.

In contrast, independent claim 14 includes:

> a controller capable of:
> extracting a piece of code information which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit, and
> generating a folder name or a file name relating to the data, based on the piece of code information thus extracted.

A means-plus-function recitation claim is construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. The scope of such claim is different from a similar claim that does not have such means-plus-function recitation. Therefore, the scope of claim 14 having a ***controller*** capable of extracting a piece of code information which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit, and generating a folder name or a file name relating to the data, based on the piece of code information thus extracted is different from the scope of claim 1

which comprises an ***extraction means*** for extracting a piece of code information which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit, and a ***name generation means*** for generating a folder name or a file name relating to the data based on the piece of code information extracted by the extraction means. Applicant has the right to recite his invention with claims of different/varying scope. Since the scope of claims 1 and 14 are different, there is no justification for the Examiner to allege that independent claim 14 is a substantial duplicate of independent claim 1.

III. The Examiner contends that independent claim 15 is a substantial duplicate of independent claim 2. However, independent claim 2 comprises:

> an ***extraction means*** for extracting a piece of the code information which is possessed on said image, from the table, corresponding to a piece of the image data acquired by picking up an image by the image pickup unit; and
>
> a ***name generation means*** for generating a folder name or a file name relating to the data based on the piece of the code information extracted by the extraction means.

In contrast, independent claim 15 includes:

> a ***controller*** capable of:
>
> extracting a piece of the code information which is possessed on said image, from the table, corresponding to a piece of the image data acquired by picking up an image by the image pickup unit; and
>
> generating a folder name or a file name relating to the data, based on the piece of the code information thus extracted.

Therefore, the scope of claims 2 and 15 are different for the same reason that the scope of claims 1 and 14 are different. Since the scope of claims 2 and 15 are different, there is no

justification for the Examiner to allege that independent claim 15 is a substantial duplicate of independent claim 2.

IV. The Examiner contends that claims 16-19 are substantial duplicates of claims 3-6. However, claims 3-6 depend from independent claim 1 and claims 16-19 depend from independent claim 14. Since the scope of claims 1 and 14 are different, as noted above, there is no justification for the Examiner to allege that dependent claims 16-19 are substantial duplicates of dependent claims 3-6.

V. The Examiner contends that independent claims 25 and 26 are substantial duplicates of independent claims 12 and 13. Independent claim 12 is directed to "A ***data storage system***" that comprises an information transmitter (e.g., as recited in claim 7) as an element. Independent claim 13 is directed to "An ***information processing system***" that comprises an information transmitter (e.g., as recited in claim 7) as an element.

Claim 25 is directed to "A ***data storage system***" that comprises an information transmitter (e.g., as recited in claim 20) as an element. Independent claim 26 is directed to "An ***information processing system***" that comprises an information transmitter (e.g., as recited in claim 20) as an element.

However, claim 7 is described using means-plus-function recitations while claim 20 does not use means-plus-function recitations. That is, independent claims 12 and 13 include means-plus-function recitations while claims 25 and 26 do not. Therefore, the scope of independent

claims 12 and 13 is different from that of independent claims 25 and 26 for the same reasons that the scope of independent claims 1 and 2 is different from the scope independent claims 14 and 15. Since the scope of independent claims 25 and 26 is different from the scope of independent claims 12 and 13, there is no justification for the Examiner to allege that independent claims 25 and 26 are substantial duplicates of independent claims 12 and 13.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-26 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner contends that "a code which is possessed on said image" is not supported by the original disclosure.

The rejections are respectfully traversed.

The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the present application as originally filed reasonably conveys to the artisan that the inventor had possession, at the time of filing of the application, of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Note, for example, ***Ex parte Parks***, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) and ***In re Kaslow***, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Applicant submits that the word "possessed" means, *inter alia*, to have as a property, a quality, a characteristic or other attribute (see enclosed page from thefreedictionay.com). Therefore, "extracting a piece of code information which is possessed on said image" means extracting a piece of code information that the image has as part of it.

Page 23, line 16 to page 24, line 3, for example, of the present application describes:

> The code recognition unit 14 recognizes whether or not there is a code included in the code information DB 14b in a piece of the image data transmitted from the camera processing unit 13 as needed. ***When recognizing the code included in the code information DB 14b is in the piece of the image data***, a piece of the code information corresponding to the recognized code is read from the code information DB 14b and the piece of the code information thus read is transmitted to the name generation unit 15. Accordingly, the code recognition unit 14 functions as the extraction means that ***extracts the piece of the code information corresponding to the code included in the piece of the image data***, based on the piece of the image data obtained by picking up the image by the camera unit 13a. (Emphasis added)

It would seem that the Examiner has merely scanned the specification for literal support of "extracting a piece of code information which is possessed on said image", and not to determine whether the present application as originally filed reasonably conveys to the artisan that the inventor had possession, at the time of filing of the application, of this claimed subject matter, as is required. Applicant submits the present application, as originally filed, reasonably conveys to an artisan that the inventor had possession, at the time of filing of the application, of the claimed subject matter "extracting a piece of ***code information which is possessed on said image***".

In one of the embodiments described in the present application, a "flash ROM 14a is connected to the code recognition unit 14, and a code information DB (Table) 14b is stored in the flash ROM 14a. As shown in FIG. 2, the code information DB 14b stores codes each constituted

by a two-dimensional bar code, and pieces of the code information respectively corresponding to the codes (see page 23, lines 11-15). In addition, "the code recognition unit 14 ... extracts the piece of the code information corresponding to the code included in the image data" (see page 23, line 24 to page 24, line 1).

To expedite prosecution, independent claim 1 has been amended to delineate, *inter alia*:

> ...
> an extraction means for extracting a piece of code information ***corresponding to a code*** which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit...

Claims 2, 7, 14, and 15 have been amended to recite similar subject matter.

In addition, independent claim 7 has been amended to delineate, *inter alia*:

> ...for analyzing the code acquired by the code acquisition means and acquiring a piece of code information ***corresponding to the code acquired by the code acquisition means***;

Claims 12, 13, 20, 25 and 26 have been amended to recite similar subject matter except that claims 20, 25 and 26 refer to acquiring a piece of code information ***corresponding to the code acquired by the code extraction unit***.

Independent claims 1, 2, 7, 12-15, 20, 25 and 26, as amended, are believed to recite subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Therefore, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, as to claims 1-26, as amended, is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-26 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The rejections are respectfully traversed.

37 CFR 1.104 states:

> (b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

In addition, MPEP § 707.07(d) states:

> Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as broader than the enabling disclosure, the reason for so holding should be given; ***if rejected as indefinite the examiner should point out wherein the indefiniteness resides***; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete. (Emphasis added)

Applicant submits that the present Office Action is not complete as to all matters as the Examiner has not pointed out wherein the indefiniteness resides. More specifically, the present rejection is merely a general rejection that all claims are vague and indefinite because it is unclear to the Examiner the relationship of independent and dependent claims. However, the

Examiner has not identified any specific recitations and pointed out why the recitations are indefinite.

The Examiner should be aware that case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. ***In re Johnson***, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); ***In re Moore***, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, ***Seattle Box Co. v Industrial Crating & Packing***, 731 F.2d 381, 385, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

It should be noted also that the language in a claim does not have to be identical to language in the specification. ***In re Lukach***, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971); ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 97 (CCPA 1976), appeal after remand 646 F2d 527, 209 USPQ 554 (CCPA 1981); ***Kennecott Corp. v. Kyocera International, Inc.*** 835 F.2d 1419, 1422, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988); ***Vas-Cath Inc. v. Mahurkar***, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

Applicant submits that until the Examiner identifies the specific language of each of the claims that is considered to be vague and indefinite and the specific reason why such language is

considered to be vague and indefinite, reasonable claim amendments and/or response to this rejection cannot be proposed. In this regard, Applicant submits that he should not have to speculate as to what specific language of each of the claims the Examiner considers to be vague and indefinite and the specific reason why such language is considered vague and indefinite.

Contrary to the Examiner's position, Applicant believes that the claims 1-26, as amended, recite the invention with the degree of precision and particularity required by the statute. Therefore, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, as to claims 1-26, as amended, is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 101

Claims 7-11 and 20-24 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner continues to maintain that the claims are directed to a system comprising ***software per se***.

The rejections are respectfully traversed.

Both claims 7 and 20 relate to an "information transmitter" and both have similar features, although independent claim 7 has means-plus-function recitations while independent claim 20 has no means-plus-function recitations.

It is apparent that the present description illustrates in Embodiment 2 "a digital camera 2 as the information transmitter of the present invention" (see page 38, lines 17-18 of the present application) which is one of the examples of the "information transmitter" according to claims 7 and 20. In addition, it is apparent that the present description illustrates in Embodiment 4 a

"cellular phone 5 as the information transmitter of the present invention" (see page 60, lines 3-4 of the present application) which is one of the examples of the "information transmitter" according to claims 7 and 20.

The "digital camera" and the "cellular phone" are apparently machines of manufacture that are included in one of the four categories of invention. Vice versa, claims 7 and 20 sufficiently represent the "digital camera 2 as the information transmitter of the present invention" and the "cellular phone 5 as the information transmitter of the present invention".

Independent claim 7 recites:

> An information transmitter that transmits information to outside, comprising:
> an image pickup unit for picking up an image;
> a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit;
> an analyzing means for analyzing the code acquired by the code acquisition means and acquiring a piece of code information; and
> a transmission means for transmitting to outside the piece of code information acquired by the analyzing means.

Independent claim 20 recites:

> An information transmitter that transmits information to outside, comprising:
> an image pickup unit for picking up an image;
> a code extraction unit for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit for picking up an image;
> a decoding unit for analyzing the code which is processed on said image thus acquired and acquiring a piece of code information; and
> a communication unit for transmitting the acquired piece of code information to outside.

Thus, both independent claims 7 and 20 include, *inter alia*, an image pickup unit for picking up an image. Such image pickup unit can be, for example, camera unit 13a, which is a specific hardware element. Independent claim 7 further includes transmission means for transmitting to outside the piece of code information recited in these claims. Such transmission means and communication unit can be, for example, the communication interface 23 (see Fig. 7 of the present application), which functions as a transmitter that transmits to an external recording and reproducing apparatus 3 the piece of code information recited in these claims.

Given such specific apparatus elements that are a portion of these claims, it is submitted that the Examiner can not merely announce that the claims are directed to a system comprising software per se, as such announcement, without supporting evidence of record, is merely the opinion of the Examiner, which cannot sustain the present rejection. Therefore, independent claims 7 and 20 are directed to statutory subject matter.

Claims 8-11 depend from independent claim 7 and claims and 21-24 depend from independent claim 20. Therefore, claims 8-11 and 21-24 are directed to statutory subject matter, for the same reason that independent claims 7 and 20 are directed to statutory subject matter.

In view of the above, withdrawal of the rejection of claims 7-11 and 20-24 under 35 U.S.C. § 101 is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 1-3, 5-16 and 18-26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Igarashi et al. (U.S. Published Application No. 2004/0122866).

Claims 4 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Igarashi et al. in view of Hatanaka (U.S. Patent No. 6,438,320).

As noted in the previous Response, Igarashi et al. relates to a data control structure rewriting program for writing in data relating to images by means of a structure which can easily be utilized for other memory means. This subject matter is different from that of the inventions recited in the claims of the present application.

The invention recited in amended independent claim 1 has, *inter alia*, an image pickup unit for picking up an image and an extraction means for ***extracting a piece of code information corresponding to a code which is possessed on said image from a piece of image data*** acquired by picking up an image by the image pickup unit. Amended independent claims 2, 7, 14, and 15 recite similar subject matter. The invention recited in amended independent claim 7 has, *inter alia*, a code acquisition means for ***acquiring a code which is possessed on said image from a piece of image data*** obtained by picking up an image by the image pickup unit. Amended independent claims 12, 13, 20, 25 and 26 recite similar subject matter.

Igarashi et al. has no disclosure or suggestion regarding extracting a piece of code information/(acquiring a code) which is possessed on said image from a piece of image data that has been pickup up by, for example, a camera. Such code information/(code) would correspond, for example, to a code such as depicted in Fig. 2 (101, 102...) of the present application.

In the present invention, the code information/(code) extracted/(acquired) by the extraction/(code acquisition) means is possessed originally on the image that is picked up by the image pick up unit and the extracting/(code acquisition) means extracts the piece of code information/(acquires the code) from a piece of image data that is acquired/(obtained) by picking up the image with the image pickup unit.

The Office Action alleges that the "folder name generating means" of Igarashi corresponds to the "extracting means." However, the "folder name generating means" of Igarashi extracts common defined information which is possessed on image data generated from the image that has been picked up by an image pick up device, such as a digital camera and a camera-fitted cell phone. See paragraphs [0060] and [0066]-[0069] of Igarashi. In other words, common defined information extracted by the "folder name generating means" of Igarashi is not possessed originally on the image that is picked up by the image pick up unit; see independent claims 1, 2, 7, 12, 13, 14, 15, 20, 25 and 26. Thus, Igarashi does not extract a piece of code information/(acquire a code) which is possessed on the image from a piece of image data acquired/(obtained) by picking up an image by an image pick up device, such as a digital camera and a camera-fitted cell phone. Hatanaka fails to cure the deficiencies of Igarashi.

The Examiner has not considered the limitation "a code which is possessed on said image", as the Examiner contends this is not supported by the original disclosure (see page 4, last paragraph of the final Office Action). As noted above, Applicant disagrees with the Examiner and believes that the present application, as originally filed, reasonably conveys to an artisan that the inventor had possession, at the time of filing of the application, of the claimed subject matter

"extracting a piece of ***code information corresponding to a code which is possessed on said image***" and "acquiring a ***code which is possessed on said image***".

Furthermore, the Examiner's failure to consider the limitation "a code which is possessed on said image" is contrary to the requirement in MPEP § 2143.03 II which states:

> When evaluating claims for obviousness under 35 U.S.C. 103, ***all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed*** (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984) (Claim to a catalyst expressly excluded the presence of sulfur, halogen, uranium, and a combination of vanadium and phosphorous. Although the negative limitations excluding these elements did not appear in the specification as filed, it was error to disregard these limitations when determining whether the claimed invention would have been obvious in view of the prior art.). (Emphasis added)

This requirement applies also when evaluating claims for anticipation under 35 U.S.C. 102 since the highest form of obviousness is anticipation.

As noted above, Igarashi et al. has no disclosure or suggestion regarding extracting a piece of ***code*** information which is possessed on said image from a piece of image data that has been pickup up by, for example, a camera. Given the fact that the Examiner has not considered the limitation "extracting a piece of ***code information*** (corresponding to a code) ***which is possessed on said image***" and "acquiring a ***code which is possessed on said image***" when evaluating the independent claims under 35 U.S.C. 102, there is no basis to refute that Igarashi et al. does not disclose or suggest this feature. Therefore, independent claims 1, 2, 7, 12, 13, 14, 15, 20, 25 and 26, as amended, as well as dependent claims 3, 5, 6, 8-11, 16, 18, 19 and 21-24 are patentable over Igarashi et al., and dependent claims 4 and 17 are patentable over Igarashi et al. in view of Hatanaka.

II. In view of the above, the allowance of claims 1-26 is respectfully solicited.

CONCLUSION

In view of the above, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 8, 2009

Respectfully submitted,

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pos·sess (pə-zĕs')
tr.v. **pos·sessed, pos·sess·ing, pos·sess·es**

1. To have as property; own.
2. To have as a quality, characteristic, or other attribute: *possessed great tact.*
3. To acquire mastery of or have knowledge of: *possess valuable data.*
4.
   a. To gain or exert influence or control over; dominate: *Fury possessed me.*
   b. To control or maintain (one's nature) in a particular condition: *I possessed my temper despite the insult.*
5. To cause to own, hold, or master something, such as property or knowledge: *She possessed herself of the unclaimed goods.*
6. To cause to be influenced or controlled, as by an idea or emotion: *The thought of getting rich possessed him.*
7. *Obsolete* To gain or seize.

[Middle English possessen, from Old French possesser, from Latin possidēre, possess- : pos-, *as master*; see poti- in Indo-European roots + sedēre, *to sit*; see sed- in Indo-European roots.]

pos·ses'sor *n.*

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possess

Verb

1. to have as one's property; own
2. to have as a quality or attribute: *he possessed an innate elegance, authority, and wit on screen*
3. to gain control over or dominate: *absolute terror possessed her* [Latin *possidere*]

possessor *n*

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Thesaurus

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Verb 1. possess - have as an attribute, knowledge, or skill; "he possesses great knowledge about the Middle East"
- feature, have - have as a feature; "This restaurant features the most famous chefs in France"
- exhibit - show an attribute, property, knowledge, or skill; "he exhibits a great talent"

2. **possess** - have ownership or possession of; "He owns three houses in Florida"; "How many cars does she have?"
- own, have
- prepossess - possess beforehand
- feature, have - have as a feature; "This restaurant features the most famous chefs in France"

3. **possess** - enter into and control, as of emotions or ideas; "What possessed you to buy

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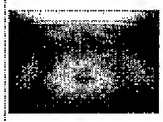
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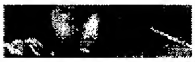
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